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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Toshiro TSUCHIDA et al.

Group Art Unit: 3713

Appln. No. : 09/986,586

Examiner: M. ONEILL

Filed : November 9, 2001

For : VIDEO GAME APPARATUS AND CONTROL METHOD THEREOF,
AND PROGRAM OF VIDEO GAME AND COMPUTER-READABLE
RECORDING MEDIUM HAVING PROGRAM RECORDED THEREON

REPLY BRIEF UNDER 37 C.F.R. 41.41

Commissioner for Patents
U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Appeal Brief-Patents
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

This Reply Brief is in response to the examiner's Answer dated November 12, 2004.

The Answer was mailed on November 12, 2004. The two month period for response was set to expire on January 12, 2005.

It is noted that a clear copy of a portion of FFVIII is being submitted. The copy that was provided to appellants was almost illegible. Thus, to ensure that a clear copy is of record, the attached copy of the portion of FFVIII is being submitted.

The Examiner Uses Impermissible Hindsight

On page 11 of the Answer, the examiner restates the reason for combining OHNUMA et al. and FFVIII. “One of ordinary skill in the art would find it obvious to use concept [sic] of awarding players for not only *beating a monster*, but for how well they do it. One of ordinary skill in the art would be motivated to do this in order to keep with the scoring methods of OHNUMA et al. but also to reward players for more than just successful defeats.” FFVIII does not teach rewarding players for “not only beating a monster, but for how well they do it.” FFVIII teaches increasing a chance of obtaining/receiving a higher SeeD ranking the quicker the player makes his way through the Fire Cavern.

Making his way through the Fire Cavern is not comparable to defeating a monster. FFVIII specifically discusses defeating a monster on the last page of the manual, stating “For winning the battle, you receive a G-Returner, Ifrit’s Card, and you gain the ability to junction with Ifrit.” That is, a single type of reward is provided for defeating the enemy character, regardless of how “well” the enemy character is defeated. No discussion is provided of rewarding players for more than just successful defeats. Thus, FFVIII lacks the concept relied upon by the examiner.

It is easy to see where the examiner finds the concept used in his reasoning for the combination. The examiner is using hindsight, relying upon features of the present

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invention. The present invention does reward players for more than just successful defeats, i.e., for finally inflicting a greater amount of damage on the enemy character when defeating the enemy character. *See, e.g.,* page 12 of the specification stating “A **characteristic feature** of the present embodiment is that, in the case where a player character finally inflicts a great amount of damage on the enemy character and defeats the enemy character, the player is provided with an advantage that the experience points acquired by the player character increase or the number of items acquired by the player character increases. This advantage is given in the case where the damage inflicted by the player character immediately before the player character defeats the enemy character (i.e., the damage finally inflicted on the enemy character) is at least equal to a threshold previously set for the enemy character.” (emphasis added). Pages 14 - 17 of the specification also discuss the same idea at such great length that the text is not being reproduced here. Thus, the concept of rewarding the player for more than just successfully defeating the enemy character originates from the disclosure of the present invention.

Although the “same words” are not present in the specification, as the examiner notes on page 12 of the Answer, the spirit of the language in the specification discloses the concept of rewarding the player for more than just successfully defeating the enemy

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character. Although “the same words” is not believed to be the standard, it is noted that the “same words” are not provided in any of the applied references either.

Consequently, there is no motivation to combine OHNUMA et al. with FFVIII.

“Final Fatal Attack”

Although appellants once paraphrased the claim language as reciting a “final fatal attack,” appellants are not arguing limitations that are not claimed. The pertinent claim language is “when the enemy is defeated by an amount of damage that is at least (is less than) the threshold value.” To understand an amount of damage when the enemy is defeated, an amount of damage caused by the final blow (i.e., attack) must be gauged. This final attack is necessarily fatal, as the claims pertain to “when the enemy is defeated.” Regardless of whether the literal claim language was used in appellants’ brief, it is believed that the argument with respect to the “final fatal attack” equally applies to the literal claim language.

FFVIII Does Not Compare Damage with a Threshold When Defeating an Enemy to Determine How to Change a Parameter

FFVIII teaches that *quickly* completing an objective may provide a character with a greater reward. FFVIII does not teach or suggest comparing with a threshold an amount

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of *damage* that defeats an enemy. In fact, the last page of the FFVIII manual states “For winning the battle, you receive a G-Returner, Ifrit’s Card, and you gain the ability to junction with Ifrit.” That is, FFVIII functions exactly the same when defeating an enemy (which involves damage) as all of the other cited prior art: a parameter (e.g., a reward) does not vary based upon the amount of damage measured when defeating the enemy; a standard reward is received no matter how much damage occurred when defeating the enemy. Regardless of whether FFVIII rewards a player for quickly completing an objective, it is clear that one of ordinary skill in the art did not contemplate changing such a parameter based upon an amount of damage because FFVIII discloses the same reward no matter how much damage occurred when the enemy was defeated.

“Enemy” Is Not Defined as a “Challenge”

The examiner appears to concede that FFVIII does not literally teach rewarding a player for how successfully he defeats an enemy. To overcome the deficiency, the examiner attempts to concoct a new definition of “enemy” to support his rejections. In particular, the examiner states that “in video games ‘the enemy’ is understood by one of ordinary skill in the art as a challenge that needs to be overcome by the player in order to solve a puzzle, defeat a monster, run through an obstruction to reach the other side.” The examiner has provided no support for this definition. Nor do appellants acquiesce to the

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examiner's definition or the examiner's speculation of what one of ordinary skill understood.

FFVIII uses the term "enemy": "The Fire Cavern is full of fire-based creatures, which makes them particularly weak against ice magic. Most of the time, you won't need to use magic to defeat your enemies; however, stronger enemies like Bombs take too long to defeat . . ." Thus, FFVIII equates enemies with creatures (i.e., characters) and not with the much broader concept of a challenge.

The American Heritage Dictionary, Second College Edition defines "enemy." 1. One that feels malice or hostility toward another; foe. 2.a. A hostile power or force. b. a member or unit of such force. 3. Something destructive or injurious in its effects; Fear is our chief enemy. Of or pertaining to a hostile power or force." None of the dictionary definitions of enemy are consistent with the examiner's new definition. Nor do appellants acquiesce to the examiner's definition. The examiner is therefore respectfully requested to support his assertion with some type of factual evidence. Thus, it is submitted that the Board should not adopt the examiner's overly broad definition of enemy, especially, when the reference upon which the examiner relies upon uses the term enemy in a manner consistent with appellant's definition, i.e., a character, and not a challenge.

Consequently, for this additional reason, it is submitted that FFVIII does not teach or suggest measuring how well a player defeats an enemy.

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The claims recite “an enemy character” referred to later simply as “the enemy.” It is clear that the claim language pertains to a character, and not a general task or objective, as taught by FFVIII. The only reason the examiner is setting forth his definition of “enemy” is to attempt to stretch the teachings of FFVIII well beyond what is disclosed or suggested to cover Appellants’ claimed invention. Again, FFVIII discloses what happens when defeating an enemy character, which is quite distinguishable from completing the Fire Cavern. Upon defeat of the enemy character in FFVIII, a standard fixed reward is provided, regardless of the amount of damage with which the enemy is defeated. No parameter varies based upon the amount of damage when the enemy is defeated.

Time Does Not Equate to Damage

Timing an event, as disclosed by FFVIII, does not teach or suggest analyzing an amount of damage when the enemy is defeated. More specifically, measuring a time does not teach or suggest a damage analysis when defeating the enemy that involves more than simply determining whether the enemy character has been defeated, as is well known.

Ohnuma et al.’s Parameters Are Unlike the Claimed Parameters

On page 16 of the Answer, the examiner appears to assert that changing a parameter of a graphics effect, sound effect and vibration effect in response to a change in

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magic power corresponds to the claim language. It is noted, however, that the claimed parameter is defined, e.g., in claim 1, as being assigned to a player character and changing when the player character defeats an enemy character. The cited portion of OHNUMA et al. lacks at least this limitation.

Thus, it is respectfully requested that the Board reverse the examiner's decision to reject claims 1, 13, and 19 for at least the above reasons.

The Combination of OHNUMA et al. and FFVIII Does Not Teach or Suggest All of the
Limitations of Claims 3, 15, or 21

The examiner states on page 19 of the Answer that when the amount of hit points of the monster reaches zero, the player acquires a larger number of items, versus nothing if the main character reaches zero hit points before the monster does. That is, the parameter is increased by zero if the monster has more than zero hit points, i.e., the monster is not yet defeated.

Such an argument does not address all of the claim limitations of claims 3, 15, and 21. For example, claim 3 refers to "the amount of damage." Claim 1 states "when the enemy is defeated by an amount of damage." Clearly the damage of claim 3, which depends from claim 1, is the same damage previously recited in claim 1, i.e., the amount of damage that defeats the enemy.

The examiner's arguments refer to both the time when the enemy is defeated and a time when the enemy is not yet defeated. When the enemy is defeated, which is the only time pertinent to claims 3, 15, and 21, only a single change of the parameter is argued by the examiner. What happens when the enemy is not defeated, i.e., zero change of the parameter, is not relevant to the claim limitations. Thus, increasing by a first number instead of a second number, based upon the damage when the enemy is defeated is not taught or suggested by the applied references.

Consequently, it is requested that the decision of the examiner to reject claims 3, 15, and 17 be reversed for at least the above reasons.

The Combination of OHNUMA et al. and KONDO et al. Does Not Teach or Suggest All
of the Limitations of Claims 4, 5, 16, 17, 22, or 23

Contrary to the examiner's assertions, claims 3 and claim 4 are not so similar that the examiner can reject one set of claims (which has not even been properly done) and the other set of claims will also be considered to be rejected. Claim 3 recites increasing the number of items by either a first number or a second number. An example would be to increase the number of items by three items in one case and to increase the number of items by four items in another case. Only a single type of item is recited in claim 3. Claim 4 recites increasing a number of first items or a number of second different items.

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For example, as stated on page 16 of the specification, a number of experience points can be increased in one case and the number of growth points can be increased in the other case. Clearly, the different types of items of claim 4 are patentably distinguishable from the single type of item in claim 3.

Consequently, it is submitted that the rejections of claims 3, 15, and 17 are not properly applied to claims 4, 16, and 22 without, at least, some further factual evidence or explanation by the examiner of how the differences are taught or suggested.

The examiner discusses, on pages 21 and 22 of the Answer, probability and acquisition factors. These limitations are found in claims 5 (probability) and claims 17 and 23 (acquisition factor). Whether claims 5, 17, and 23 are similar to one another has nothing to do with whether any other claims have a similarity. The examiner states that “the Appellant tacitly admits that probability equates to acquisition factors. Thus, it can be reasonably stated that the limitations found in claims 3, 4, 5 and the associated claims are to the same concept albeit couched different. . .” The examiner has not asserted why claim 5 is similar to claim 4 or claim 3, why claim 17 is similar to claim 15 or 16, or why claim 23 is similar to claims 21 and 22. The examiner’s arguments only apply to whether claim 5 is similar to claims 17 and 23.

Finally, in response to the examiner’s arguments on pages 21 and 22 about stochastic versus deterministic, it is noted that any process involving probability is

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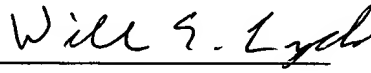
stochastic by its very definition. The prior art point system, as described, is a deterministic process which does not involve probability. The point appellants made was simply that the claimed probability process (which is stochastic) is different from the disclosed point system, which happens to be a deterministic process, at least because one process is deterministic and the other is stochastic. An analogous hypothetical argument would be that the claimed red is different from the claimed green because the claimed red is a primary color and the claimed green is a secondary color. The specification does not analyze the difference between the claimed process and the prior art process, nor is it required to do so.

Consequently, it is requested that the decision of the examiner to reject claims 5, 17, and 23 be reversed for at least the above reasons.

CONCLUSION

Thus, appellants respectfully submit that each and every pending claim of the present application meets the requirement for patentability under 35 U.S.C. §§102 and 103 and that the present application and each pending claim are allowable over the prior art of record. Thus, the decision of the examiner to reject claims 1 - 6 and 13 - 24 should be reversed, and the application should be remanded to the examiner for prompt issuance of a Notice of Allowance.

Respectfully submitted,
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